

REMARKS

Applicant requests favorable reconsideration and withdrawal of the objection and rejections in view of the foregoing amendments and the following remarks.

Claim Status

Claims 1, 3-5, 7-9, and 11-14 remain pending in the application, with Claims 1, 5, and 9 being independent. Claims 1, 5, 9, and 11 through 13 have been amended to even more succinctly define the invention and/or to improve their form. Support for the amendments can be found in the specification as originally filed, for example, at page 24, line 26, through page 25, line 23. It is respectfully submitted, therefore, that no new matter has been presented.

Claims Objection

Claims 1, 5, and 9 have been objected to for the reasons set forth at pages 4 and 5 of the Official Action. In response, Claims 1, 5, and 9 have been amended in the manner kindly suggested by the Examiner. Accordingly, the objection has been overcome and should be withdrawn.

Claim Rejection Under 35 U.S.C. §112

Claims 9 through 12 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The rationale underlying the rejection is set forth at pages 5 and 6 of the Official Action.

Response to Claim Rejection Under 35 U.S.C. §112

The Official Action states that the specification does not describe the invention in such a way as to reasonably convey to one of ordinary skill in the art at time of invention that the inventor had possession of the claimed invention. The Examiner has emphasized that the claims are directed to a computer program, stored on a computer readable medium. It is unclear what the Examiner believes the Applicant did not have possession of at the time of invention, as a computer program product with, *inter alia*, code for discrimination were set forth in the originally filed claims. In Applicant's view, at least page 29, line 1, through page 31, line 16 of the originally-filed specification provides clear support for the claimed subject matter. Further, it is now well accepted that a satisfactory description may be in the original claims or any other portion of the originally-filed specification. See MPEP § 2163, paragraph I. As a computer program product was set forth in the original disclosure and claims, the Examiner has not established how regarding how the specification, as originally filed, is lacking. The rejection is traversed.

The Official Action also states that the specification lacks computer program codes for enabling one to make and use the invention. It is not clear if the Examiner is also rejecting the claims for a lack of enablement, as the claims are not explicitly rejected for not meeting the enablement requirement. It is noted that enablement and written description are separate requirements under 35 U.S.C. §112, that each require the Examiner to state the reason why the Examiner believes the disclosure is incomplete.

When basing a rejection on the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of 35 U.S.C. §112, USPTO personnel must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person

of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971). See also MPEP § 2106.01, paragraph III. As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). See also MPEP § 2164.04. As the Examiner has not stated any reason why the disclosure is asserted to not be enabling, the rejection is traversed.

Claim Rejection Under 35 U.S.C. §101

Claims 9 through 12 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The rationale underlying the rejection is set forth at pages 6 through 8 of the Official Action.

Response to Claim Rejection Under 35 U.S.C. §101

The basis for the rejection is unclear as the claims, as previously presented, are directed to subject matter that the Official Action admits is statutory. As the Examiner correctly notes, a computer program per se can merely be a set of instructions, which is non-functional descriptive material. The claims rejected under 35 U.S.C. § 101, however, are not directed to a computer program per se, but rather to a computer program stored on a computer-readable medium.

The Official Action further states that “a ‘computer readable storage medium stored or embedded with a computer program’ is a statutory functional descriptive material,” [sic] on pages 2 and 3. It does not follow from this statement that there is any reason for the § 101 rejection, as this is precisely what is being claimed. Claims 9-12, as amended, are directed to a “computer program stored on a computer-readable medium for instructing a computer to execute an image forming method” (emphasis added). A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. As Claims 9-12 are directed to a claimed computer-readable medium encoded with a computer program and is thus statutory, the rejection is traversed.

Claim Rejection Under 35 U.S.C. §102

Claims 1, 4, 5, 7 through 9, and 11 through 14 have been rejected under 35 U.S.C. § 102(e) as being anticipated by newly-cited Sugimoto (U.S. Patent No. 7,298,522), which corresponds to previously-cited U.S. Patent Application Publication No. 2003/0043392. The rationale underlying the rejection is succinctly set forth at pages 8 through 11 of the Official Action.

Response to Claim Rejection Under 35 U.S.C. §102

Applicant respectfully traverses the rejection. Without conceding the propriety of the rejection and solely to expedite prosecution, Applicant has amended independent Claims 1, 5, and 9 to even more clearly distinguish the invention over the cited art. To this end, Applicant

respectfully submits Claims 1, 5, and 9 are allowable over the cited references, for at least the following reasons.

Amended Claim 1 recites an image forming apparatus having a discrimination unit for discriminating a type of object contained in input data; and a processing unit for applying reduction processing to a thin line contained in a graphical object using a result of discrimination by the discrimination unit. The reduction processing reduces, based upon a user instruction, an amount of colorant forming the thin line contained in the graphical object to a first amount of the colorant, when a thin-line correction mode is turned on. Further, the reduction processing reduces, based upon a specified value, an amount of colorant forming the thin line contained in the graphical object to a second amount of the colorant that is more than the first amount when the thin-line correction mode is not turned on.

Amended independent Claim 5 recites an image forming method, including a processing step of applying reduction processing to a thin line contained in a graphical object using a result of discrimination by the discrimination unit, similar to the feature recited in Claim 1.

Amended independent Claim 9 recites a computer program stored on a computer-readable medium for instructing a computer to execute an image forming method, the method including a processing step of applying reduction processing to a thin line contained in a graphical object using a result of discrimination by the discrimination unit, similar to the feature recited in Claim 1.

By virtue of the invention, the appropriate toner reduction processing can be applied with regard to graphical objects without toner reduction processing being applied to images, i.e., photographic images. Further, if toner spray becomes noticeable in the vicinity of thin lines and the user turns a thin-line correction mode on from the printer driver or control panel, then

appropriate toner reduction processing can be applied by setting values in response to the activation of this correction mode. Accordingly, when a user wishes to prevent spattering of toner forming a graphical thin line, a user can turn on the thin-line correction mode.

The Official Action asserts Sugimoto discloses an image forming apparatus comprising, *inter alia*, a processing unit for applying a reduction processing which suppresses the amount of colorant to a thin line in a graphic. Specifically, the Official Action cites to the disclosure at column 13, line 46 through column 14, line 16 of Sugimoto as disclosing determining a toner save level in accordance with line width.

Applicant respectfully submits, however, that Sugimoto does not teach or suggest that the reduction processing reduces, based upon a user instruction, an amount of colorant forming the thin line contained in the graphical object to a first amount of the colorant, when a thin-line correction mode is turned on, and that the reduction processing reduces, based upon a specified value, an amount of colorant forming the thin line contained in the graphical object to a second amount of the colorant that is more than the first amount when the thin-line correction mode is not turned on, as recited in independent Claims 1, 5, and 9. In fact, Sugimoto appears to disclose that no toner save operation occurs when a toner save level is not specified. For example, in column 8, lines 44-52, which is specifically referred to in the Official Action, Sugimoto discloses that if the toner save level is not specified, then the lookup table with no toner save is selected.

Further, at column 13, lines 53-61, Sugimoto discloses that the brightness of colors used, not the amount of toner, is reduced when forming thin lines. Thus, Sugimoto does not teach or suggest that the reduction processing reduces an amount of colorant forming the thin line contained in the graphical object.

For at least the foregoing reasons, Applicant submits that Sugimoto does not disclose or suggest the image forming apparatus recited in Claim 1, the image forming method recited in Claim 5, or the computer program stored on a computer-readable medium recited in Claim 9.

Dependent Claims

Claims 3, 4, 7, 8, and 11-14 are directly dependent from either independent Claims 1, 5, and 9 and are allowable by virtue of their dependency and in their own right for further defining the invention.

Conclusion

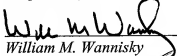
In view of the above amendments and remarks, it is respectfully submitted that the pending claims are allowable over the references of record, and that the application is in condition for allowance.

Favorable reconsideration and early passage to issue of the application are earnestly solicited.

It is believed that no fee is required for this Amendment. However, the Commissioner is hereby authorized to charge any fee which may be deemed necessary in connection with this paper to Deposit Account No. 06-1205.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'William M. Wannisky', is written over a horizontal line.

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